

REMARKS

Applicants have thoroughly considered the Examiner's remarks in the December 6, 2007 Office action and have amended the application to more clearly set forth aspects of the invention. This Amendment A amends claims 1, 11-12, 23-24, 29 and 36-40. No new matter has been added. Claims 1-40 are thus presented in the application for further examination. Reconsideration of the application as amended and in view of the following remarks is respectfully requested.

Claim Rejections Under 35 U.S.C. §101

Claims 11, 23, 27, 29, 30, 33, 34, and 36-40 stand rejected under 35 U.S.C. §101 for being inclusive of data signals that are not statutory subject matter. To advance prosecution, however, Applicants have amended claims 11, 23, and 36-40 to recite "computer storage media" which excludes data signals. See the specification at paragraph [0052] for support for this amendment. With respect to claims 27, 29, 30, 33, and 34, Applicants respectfully submit that these claims do not include any reference to a computer-readable medium or computer readable media. Therefore, they are clear and do not include nonstatutory subject matter. Therefore, Applicants respectfully request that the rejection of claims 11, 23, 27, 29, 30, 33, 34, and 36-40 be withdrawn in view of this amendment.

Claim Rejections Under 35 U.S.C. §103

Claims 1, 2, 4-9, 11-17, 23-27, 29-33 and 36-39 stand rejected under 35 U.S.C. §103(a) as being unpatentable over US Pub. No. 2003/0212566 to Fergusson et al. and further in view of US Pub No. 2004/0122730 to Tucciarone. Applicants respectfully submit that the combined references of Ferguson and Tucciarone fail to disclose or suggest each and every element of the rejected claims.

As an overview, Applicants respectfully submit that Fergusson discloses a method and system for assisting organizations in complying with Do-Not-Call laws. Fergusson describes its invention from the perspective that the telemarketer or sales person who views a plurality of perspective clients in an entry in at least one of the DNC listings and determines from the listings whether the perspective client can be contacted. See also FIGS. 4 and 5. On the other hand, Tucciarone discloses or suggests a method or system of "an on-request service precluding unwanted solicitation of electronic messages."

On the other hand, embodiments of the invention as recited in amended claim 1 describe a method and system that enable the recipient and sender perform an interactive communication to actively engage the determination of the compliance with anti-spam rules, laws, and regulations. For example, amended claim 1 recites, in part:

receiving an incoming communication from a recipient of communications;
identifying a location of the recipient based on the received incoming communication;
storing data indicating a last time that the incoming communication is received by the sender **based on the received incoming communication;**
sending a communication to the recipient if the stored data indicates that the time between the last time that the incoming communication is received by the sender and a present time does not exceed a predetermined time limit, **said predetermined time limit being defined and prescribed by anti-spam rules, laws and regulations of the identified location of the recipient; and**
sending information to the recipient, said information indicating the last time that the incoming communication from the recipient is received.

Amended claim 1 includes the subject matter of claim 3, which according to page 35 of the Office action, and is not taught by the combination of Fergusson and Tucciarone. Applicants respectfully submit that the combined references of Fergusson, Tucciarone, and Griebenow fail to disclose each and every element of amended claim 1 because Griebenow fails to cure the deficiencies of Fergusson and Tucciarone. In particular, Applicants respectfully submit that Griebenow fails to disclose “**said predetermined time limit being defined and prescribed by anti-spam rules, laws and regulations of the identified location of the recipient.**” While Griebenow describes about sending notices when a subscription expires, Applicants respectfully submit that Griebenow fails to describe the predetermined time limit being defined and prescribed by anti-spam rules, laws, and regulations of the identified location of the recipient. Applicants also respectfully submit that Fergusson fails to recite this feature as well. Although Fergusson describes in paragraph [0012] about the different ways Fergusson’s system may “**mine the one or more databases to determine the length of time since the client transacted business with the organization, ...**” (emphasis added), Applicants respectfully submit that Fergusson teaches away from at this feature of aspects of the invention because amended claim 1 recites “storing data indicating a last time that the incoming communication is received by the sender **based on the received incoming communication.**” In other words, Fergusson discloses or suggests mining databases and making determination from the databases that the existing

relationship exists or not. However, with combined with the feature “sending information to the recipient, said information indicating the last time that the incoming communication from the recipient is received” as recited in claim 1, embodiments of the invention do not automatically draw that conclusion because the recipient is given the opportunity to see the information relating to the last time that the incoming communication from the recipient is received. This is also not taught by Tucciarone because Tucciarone discloses the system that enables the user to “unilaterally” make the decision, (i.e., on-request). Therefore, for at least the reasons above, Applicants respectfully submit that the combined references of Fergusson, Tucciarone, and Griebenow fail to disclose each and every element of the rejected claims. Hence, the rejection of claims 1, 2, 4-9, 11-17, 23-27, 29-33 and 36-39 under 35 U.S.C. §103(a) should be withdrawn.

Amended claim 12 recites, in part: “determining if a communication complies with a rule, law, or regulation of the identified location of the recipient, said communication indicating if the stored data indicates that the time between the last time that the incoming communication is received by the sender and a present time does not exceed a predetermined time limit, said predetermined time limit being defined and prescribed by anti-spam rules, laws and regulations of the identified location of the recipient; sending information to the recipient, said information indicating the last time that the incoming communication from the recipient is received...; wherein if multiple locations of the recipient are identified, the location of the recipient is the location having the most restrictive rule law, or regulation among the identified multiple locations.” For at least the reasons above, Applicants respectfully submit that amended claim 12 includes the subject matter of claims 1 and 3 and are thus distinguishable over Fergusson, Tucciarone, and Griebenow.

Furthermore, amended claim 12 includes the subject matter of claim 18. While the Office argues that Fergusson discloses that a supervisor could set various rules associated with the different states, Applicants respectfully submit that Fergusson and, as well as Tucciarone and Hamer, fails to disclose or suggest “the location of the recipient is the location having the most restrictive rule law, or regulation among the identified multiple locations.” In other words, just the fact that a supervisor may selectively set various rules, as disclosed in paragraph [0115], this does not render Fergusson to disclose or suggest that “the location of the recipient is the location having the most restrictive rule law, or regulation among the identified multiple locations.” In other words, Fergusson’s system actually would teach away from embodiments of the invention

because the supervisor may elect to use the rules from the least restrictive location if there are multiple locations associated with the recipient. In fact, Applicants respectfully submit that Fergusson fails to deal with the situation where there are more than one location associated with a perspective recipient. Hence, Applicants respectfully submit that the rejection of claim 12 and its dependent claims under 35 U.S.C. §103(a) should be withdrawn.

Similarly, amended claim 24 recites:

a memory area adapted to store data indicating a last time that an incoming communication from a recipient is received by the sender, said stored data of the incoming communication indicating a location of the recipient based on the received incoming communication; and

a device adapted to send a communication to the recipient if the stored data indicates that the time between the last time that the incoming communication is received by the sender and a present time does not exceed the predetermined time limit, said predetermined time limit being defined and prescribed by anti-spam rules, laws and regulations of the identified location of the recipient; and

wherein the device sends information to the recipient, said information indicating the last time that the incoming communication from the recipient is received.

For at least the reasons above, Applicants respectfully submit that claim 24 and its dependent claims are patentable over the cited art. Hence, the rejection of claims 24-27 under 35 U.S.C. §103(a) should be withdrawn.

Amended claims 29 and 36 similarly recited features described above that are also patentable over the cited art. Hence, the rejection of claims 29-33 and 36-39 under 35 U.S.C. §103(a) should be withdrawn.

Claim 10 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Fergusson and Tucciarone as applied to claim 1 above, and further in view of Tucciarone. Because amended claim 1 now includes the subject matter of claim 3 and the Office admitted on page 35 that Fergusson and Tucciarone fail to disclose or suggest the subject matter of claim 3, Applicants respectfully submit that claim 10 now depends from the amended claim 1 and is also patentable over the cited art. Hence, the rejection of claim 10 under 35 U.S.C. §103(a) should be withdrawn.

Claim 28 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Fergusson and Tucciarone as applied to claim 24 above, and further in view of Tucciarone. Because amended claim 24 now includes the subject matter of claim 3 and the Office admitted on page 35 that Fergusson and Tucciarone fail to disclose or suggest the subject matter of claim 3, Applicants respectfully submit that claim 28 now depends from the amended claim 24 and is also patentable over the cited art. Hence, the rejection of claim 28 under 35 U.S.C. §103(a) should be withdrawn.

Claim 40 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Fergusson and Tucciarone as applied to claim 36 above, and further in view of Tucciarone. Because amended claim 36 now includes the subject matter of claim 3 and the Office admitted on page 35 that Fergusson and Tucciarone fail to disclose or suggest the subject matter of claim 3, Applicants respectfully submit that claim 40 now depends from the amended claim 36 and is also patentable over the cited art. Hence, the rejection of claim 40 under 35 U.S.C. §103(a) should be withdrawn.

Claims 20-21 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Fergusson and Tucciarone as applied to claim 12 above, and further in view of US Pub. No. 20040017899 to Garfinkel et al. For at least the reasons above, Applicants respectfully submit that Garfinkel fails to cure the deficiencies of Fergusson and Tucciarone. Garfinkel discloses a system and method to determine “if caller information is present. If the caller information is not present, the system will retrieve a caller information from the insert caller information database. The caller information is chosen from the database based on the originating trunk identification.” Garfinkel, paragraph [0011]. Applicants respectfully submit that this disclosure and the rest of Garfinkel’s teaching fails to disclose at least the features of “, said communication indicating if the stored data indicates that the time between the last time that the incoming communication is received by the sender and a present time does not exceed a predetermined time limit, said predetermined time limit being defined and prescribed by anti-spam rules, laws and regulations of the identified location of the recipient; sending information to the recipient, said information indicating the last time that the incoming communication from the recipient is received.” Hence,

Applicants respectfully submit that claims 20-21 are patentable over Fergusson, Tucciarone and Garfinkel. Hence, the rejection of claims 20-21 under 35 U.S.C. §103(a) should be withdrawn.

Claim 34 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Fergusson and Tucciarone as applied to claim 29 above, and further in view of Garfinkel. For at least the reasons above, Applicants respectfully submit that Garfinkel fails to cure the deficiencies of Fergusson and Tucciarone. Hence, the rejection of claim 34 under 35 U.S.C. §103(a) should be withdrawn.

Claims 18-19 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Fergusson and Tucciarone as applied to claim 12 above, and further in view of US Pub. No. 20040128321 to Hamer. Claim 18 has been canceled and amended claim 12 incorporates the subject matter of claim 18. As such, Applicants respectfully submit that for at least the reasons above, Applicants respectfully submit that claim 19 is patentable over the cited art. Hence, the rejection of claim 19 under 35 U.S.C. §103(a) should be withdrawn.

Claim 3 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Fergusson and Tucciarone as applied to claim 1 above, and further in view of US Pat. No. 5850520 to Griebenow et al. Claim 3 has been canceled, and the subject matter of claim 3 has been incorporated into the subject matter of amended claim 1. Hence, based on at least the above reasons, Applicants respectfully submit that amended claim 1 is patentable over Fergusson, Tucciarone, and Griebenow.

Claim 22 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Fergusson and Tucciarone as applied to claim 12 above, and further in view of US Pat. No. 7155608 to Malik et al. For at least the reasons above, Applicants respectfully submit that the combined references of Fergusson, Tucciarone and Malik fail to disclose each and every element of claim 22. Hence, the rejection of claim 22 under 35 U.S.C. §103(a) should be withdrawn.

Claim 35 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Fergusson and Tucciarone as applied to claim 12 above, and further in view of Malik. For at least the

reasons above, Applicants respectfully submit that the combined references of Fergusson, Tucciarone and Malik fail to disclose each and every element of claim 35. Hence, the rejection of claim 35 under 35 U.S.C. §103(a) should be withdrawn.

Applicants submit that the claims are allowable for at least the reasons set forth herein. Applicants thus respectfully submit that claims 1-40 as presented are in condition for allowance and respectfully request favorable reconsideration of this application.

Although the prior art made of record and not relied upon may be considered pertinent to the disclosure, none of these references anticipates or makes obvious the recited aspects of the invention. The fact that Applicants may not have specifically traversed any particular assertion by the Office should not be construed as indicating Applicants' agreement therewith.

Applicants wish to expedite prosecution of this application. If the Examiner deems the application to not be in condition for allowance, the Examiner is invited and encouraged to telephone the undersigned to discuss making an Examiner's amendment to place the application in condition for allowance.

The Commissioner is hereby authorized to charge any deficiency or overpayment of any required fee during the entire pendency of this application to Deposit Account No. 19-1345.

Respectfully submitted,

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